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| EXAMINER |
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NGUYEN, PHUOC H

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| ART UNIT | PAPER NUMBER |
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2143

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/437,496

Applicant(s)

INOUE ET AL.

Examin r

Phuoc H. Nguyen

Art Unit

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-- Th MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on August 26, 2003.
2. Original application contained claims 1-20. Applicant amended claims 17, 19, and 20, and added claims 21-23. Amendment filed on August 26, 2003 have been entered and made of record. Therefore, pending claims 1-23 are presented for further consideration and examination.

Response to Arguments

3. Applicants' arguments have been fully considered but they are not persuasive.

Applicants argued in page 12 second paragraph for claim 1 that the cited reference by Wicks does not disclose a processing unit configured to obtain a prescribed information regarding the computer network that is necessary or utilizable in operating an application program to be operated on the portable terminal device by being connected to the computer network. The examiner respectfully submits that Figure 1 of Wicks's reference disclose the limitations cited in claim 1 as the processor unit is inside the handheld device (110), and the handheld device (110) is connected to personal information communicator (PIC, 112) to form the computer network. Each morning when the user show up for work would check the display screen on the base station (108) to check to see whether the user has electronic mail, voice message, faxes, etc. And by pressing a key on the handheld communicator, the user can retrieve voice messages or it can forward electronic mail, faxes, or other program application delivered to the personal information communicator.

Applicants further argued Wicks does not provides no teaching directed to such a portable terminal device with an improved handling of a user interface or omission of tedious

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operations. The examiner respectfully submits that Wicks's invention provides a personal communications routing system with an improved user interface that is uniform among the different communication network, information types and devices which the system is design to handle (col. 12, lines 47-54).

Applicants still have failed to clearly disclose the novelty of the invention and identify specific limitation which would define patentable distinction over prior art.

Claims 2-14, and 16, is rejected at least by virtual of their dependency on independent and by other reasons set forth in the previous office action [see Paper No. 3]

According, rejections for claims 1-23 are presented as below.

DETAILED ACTION

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 22, the limitation "not in contact with" in lines 4 and line 13 is unclear whether there is no physical contact between the portable terminal device and first/second computer device or wirelessly connected. For examining purposes the examiner consider not in contact with is wirelessly connected between the portable terminal device and first/second computer.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4,6-14,16-17, and 19 rejected under 35 U.S.C. 102(e) as being anticipated by Wicks et al. U.S. Patent 5,796,394.

3. Referring to claims 1,17, and 19, Wicks reference disclose a network connection unit configured to establish a connection to a computer network (Fig. 1; and col. 5, lines 10-13); a local network connection unit configured to establish a connection to a local network different from the computer network, the local network being a network locally defined among the portable terminal device and at least one other computer device (Fig. 1); and a processing unit (CPU inside mobile 110) configured to obtain a prescribed information regarding the computer network (col. 5, lines 5-19) that is necessary or utilizable in operating an application program to be operated on the portable terminal device by being connected to the computer network, from said at least one other computer device connected to the portable terminal device via the local network (Fig. 1, mobile 100 and PIC) through the local network connection unit, carry out a prescribed processing for the application program according to at least a part of the prescribed information, and execute the application program by using a result of the prescribed processing

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and being connected to the computer network through the network connection unit (Fig. 1; col. 5, lines 39-47).

4. Referring to claim 2, Wicks reference disclose the processing unit carries out the prescribed processing to make a prescribed setup regarding the computer network (col. 3, lines 52-67).

5. Referring to claim 3, Wicks reference disclose the processing unit makes the prescribed setup by storing said at least a part of the prescribed information into a prescribed memory region for the application program, either as obtained from said at least one other computer device or by converting said at least a part of the prescribed information into a format matching with the application program and/or a user interface of the portable terminal device (col. 2, lines 59 through col. 3, lines 13).

6. Referring to claim 4, Wicks reference disclose the processing unit obtains-the prescribed information related to a specified type of application program that exists in said at least one other computer device (col. 7, lines 54 through col. 8, lines 20).

7. Referring to claim 6, Wicks reference disclose the local network enables data exchanges between the portable terminal device and said at least one other computer device by using a wireless LAN (Local Area Network), a point-to-point wireless device, or an infrared as a medium (col. 4, lines 63-67).

8. Referring to claim 7, Wicks reference disclose the processing unit carries out data exchanges on the local network only with a computer device that is authenticated by a prescribed mutual authentication procedure (col. 11, lines 17-32).

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9. Referring to claim 8, Wicks reference disclose the processing unit carries out a procedure for obtaining the prescribed information for each one of a plurality of application programs installed on the portable terminal device, at a timing of activation of the portable terminal device (col. 10, lines 1-24).

10. Referring to claim 9, Wicks reference disclose the processing unit carries out a procedure for obtaining the prescribed information for the application program at a timing of activation of the application program (col. 10, lines 1-24).

11. Referring to claim 10, Wicks reference disclose the processing unit carries out a procedure for transferring the prescribed information obtained from a first computer device via the local network to a second computer connected to the local network (col. 9, lines 36-44).

12. Referring to claim 11, Wicks reference disclose the processing unit carries out a procedure for transferring the prescribed information obtained via the local network to one or a plurality of computer devices connected to the local network (col. 9, lines 36-44).

13. Referring to claim 12, Wicks reference disclose the network connection unit carries out communications via the computer network through a radio base station (Fig. 1; col. 9, lines 36-44).

14. Referring to claim 13, Wicks reference disclose the prescribed information is setup data or input data for the application program (col. 12, lines 5-24).

15. Referring to claim 14, Wicks reference disclose a user interface for enabling user input into the portable terminal device, wherein the processing unit carries out the prescribed processing to enter the setup data or the input data into the portable terminal device in a form

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utilizable by the application program, without using the user interface (col. 5, lines 37-52; and col. 8, lines 1-9).

16. Referring to claim 16, Wicks reference disclose the processing unit receives from the portable terminal device via the local network a first request for obtaining the identification information, transmits a first reply containing the identification information to the portable terminal device via the local network in response to the first request, receives from the portable terminal device via the local network a second request for obtaining the prescribed information, and transmits a second reply containing the prescribed information to the portable terminal device via the local network in response to the second request (col. 8, lines 37 through col. 9, lines 49).

17. Claims 22 and 23 rejected under 35 U.S.C. 102(e) as being anticipated by Hocker et al. U.S. Patent 6,072,468.

18. Referring to claim 22, Hocker reference disclose placing the portable terminal device nearby but not in contact with the first computer device, establishing a connection over the local network between the first computer device and the portable terminal device (Figure 2, 32); sending a request from a particular data message, from the portable terminal device to the first computer device, transmitting, over the local network, the particular data from the first computer device to the portable terminal device, in response to receipt of the request for particular data message (Figure 2, the user can use the data mouse to request the data from one computer and store it in the data mouse memory.); placing the portable terminal device nearby but not in contact with the second computer device, the second device being not positioned nearby the first computer device, establishing a connection over the local network between the second computer

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device and the portable terminal device (Figure 2, 32'); sending a request to transmit particular data message, from the portable terminal device to the second computer device, the request to transmit particular data message being sent over the local network, sending a ready to receive particular data message, from the second computer device to the portable terminal device, the ready to receive particular data message being sent over the local network, transmitting, over the local network, the particular data from the portable terminal device to the second computer device (Figure 2, the user can initiate and send the data from the data mouse memory to second computer.); wherein no component other than the portable terminal device is utilized in the transfer of the particular data from the first computer device to the second computer device via the local network (Figure 2; and col. 1, lines 31-46).

19. Referring to claim 23, Hocker reference disclose local network is wireless network (Abstract; Figures 1, and 2).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 5,15,18, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks in view of Moore et al. U.S. Patent 6,112,244.

Wicks reference disclose a local network connection unit configured to establish a connection to a local network that is locally defined among the computer device and a portable terminal device (Fig. 1; col. 4, lines 36 through col. 5, lines 64); however, Wicks fail to teach us

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that identifying a specified type of application program that exists in the computer device, or a prescribed information related to said specified type of application program, in response to a request received from the portable terminal device via the local network through the local network connection unit.

Moore reference disclose a processing unit configured to return a reply containing an identification information for identifying a specified type of application program that exists in the computer device, or a prescribed information related to said specified type of application program, in response to a request received from the portable terminal device via the local network through the local network connection unit (col. 4, last paragraph through col. 5, lines 5).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Moore's teaching into Wicks's method to identify the type of application program that exist in the computer device, because the application identifier can be use to decompressing the message with the right format.

22. Claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks and Moore in view of Hocker et al. U.S. Patent 6,072,468.

Wicks and Moore reference disclose Wicks reference disclose a local network connection unit configured to establish a connection to a local network that is locally defined among the computer device and a portable terminal, and identifying a specified type of application program that exists in the computer device, or a prescribed information related to said specified type of application program, in response to a request received from the portable terminal device via the local network through the local network connection unit; however, Wicks and Moore reference fail to disclose the data to be downloaded into the computer device was previously uploaded to

the portable terminal device from another device via the local network, and the data to be downloaded into the computer device only passes through the portable terminal device as the data is sent from the another computer device to the computer device.

Hocker reference disclose a data wireless mouse which has a storage that can receive data from one computer and transmitted to another computer (see figure 2; and col. 1, lines 23-46).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Hocker's method to Moore's and Wicks's to use a portable device to transmitted the data from one computer to another computer, because it provides a simple way to transfer data among diverse system.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Smith U.S. Patent 5,930,472

Yamagishi U.S. Patent 5,838,926

Lincke et al. U.S. Patent 6,397,259

Brownrigg et al. U.S. Patent 6,249,516


Hocker et al. U.S. Patent 6,137,476

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu (7AM-4:30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Phuoc H. Nguyen
Examiner
Art Unit 2143



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November 7, 2003



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SUPERVISORY PATENT EXAMINER
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